

Appln. No. 09/751,737

Amendment dated January 29, 2004

Reply to Office Action mailed March 31, 2003

### **REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 8 and 11 through 15 remain in this application.  
Claims 9 and 10 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

### **Paragraphs 1 and 2 of the Office Action**

Claims 1, 6, 11 and 12 have been rejected under 35 U.S.C. §102(b) as being anticipated by US Patent 6,131,399 to Hall.

In regard to claims 1 and 11, it is submitted that the Hall reference does not disclose, teach or suggest "said signaling means comprising a translucent cylindrical housing and a light, said cylindrical housing being mounted on a counter such that said cylindrical housing extends upwardly from said counter, said light being illuminatable upon actuating by said detecting means, said light being removably mounted in said housing opposite said counter such that said light is adapted for being readily seen by the potential buyer positioned anywhere along the length of said counter when said light is illuminated by said detecting means". The Hall reference teaches a refrigerated vending machine that fails to teach the signaling means comprising a translucent cylindrical housing extending upwardly from a counter and a light mounted in the housing so that the light emitted by the light can be seen many different positions along the counter as claimed by the applicant. Therefore, it is submitted that the Hall reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claim 6 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 6 is also believed to be allowable over the cited reference.

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Claim 12 is dependent upon claim 11, particularly as amended, and therefore incorporates the requirements of claim 11. Thus, claim 12 is also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1, 6, 11 and 12 is therefore respectfully requested.

**Paragraphs 3 and 4 of the Office Action**

Claims 2-5, 7 and 13 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Hall.

In regard to claims 1 and 11, it is submitted that the Hall reference does not disclose, teach or suggest "said signaling means comprising a translucent cylindrical housing and a light, said cylindrical housing being mounted on a counter such that said cylindrical housing extends upwardly from said counter, said light being illuminatable upon actuating by said detecting means, said light being removably mounted in said housing opposite said counter such that said light is adapted for being readily seen by the potential buyer positioned anywhere along the length of said counter when said light is illuminated by said detecting means". As discussed above, the Hall reference fails to teach the signaling means comprising a translucent cylindrical housing extending upwardly from a counter and a light mounted in the housing so that the light emitted by the light can be seen many different positions along the counter as claimed by the applicant. Therefore, it is submitted that the Hall reference would not lead one to the combination of features as claimed by the applicant.

Claims 2 through 5 and 7 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 through 5 and 7 are also believed to be allowable over the cited reference.

Claim 13 is dependent upon claim 11, particularly as amended, and therefore incorporates the requirements of claim 11. Thus, claim 13 is also believed to be allowable over the cited reference.

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Withdrawal of the §103(a) rejection of claims 2-5, 7 and 13 is therefore respectfully requested.

**Paragraph 5 of the Office Action**

Claims 1-15 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 5,196,686 to Leister in view of US Patent 6,550,685 to Kindberg.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

In regard to claims 1, 11 and 15, it is submitted that the combination of Leister with Kindberg is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said signaling means comprising a translucent cylindrical housing and a light, said cylindrical housing being mounted on a counter such that said cylindrical housing extends upwardly from said counter, said light being illuminatable upon actuating by said detecting means, said light being removably mounted in said housing opposite said counter such that said light is adapted for being readily seen by the potential buyer positioned anywhere along the length of said counter when

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said light is illuminated by said detecting means". The Leister reference teaches a checkout system that fails to teach the signaling means comprising a translucent cylindrical housing extending upwardly from a counter and a light mounted in the housing so that the light emitted by the light can be seem many different positions along the counter as claimed by the applicant. Further, the Leister is completely lacking in any motivation for such a combination of features to indicate that an item has passed its expiration date. The Office Action states that Leister discloses the signaling means (42, 44 and 46), the context of Leister at column 2 lines 40 through 45 is reproduced below.

Located along the opposite side of the counter 20 adjacent the customer 39 (FIG. 6) is a raised housing member 40 which includes a customer display 42 a pair of indicator lights 44 and 46 indicating whether the scan operation resulted in a good read (green) or a bad read (red).

It is noted that the Leister reference uses the lights to indicate whether the article was properly scanned in the scan operation or not and in no way provides any motivation for the use of the lights to indicate whether the article being scanned has passed the expiration date of the article. The Kindberg reference teaches an apparatus utilizing visually distinctive barcodes that fails to teach the signaling means comprising a translucent cylindrical housing extending upwardly from a counter and a light mounted in the housing so that the light emitted by the light can be seem many different positions along the counter as claimed by the applicant.

Therefore, it is submitted that the combination of the Leister reference with the Kindberg reference would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation

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provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)  
(emphasis in original).

Claims 2 through 8 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 through 8 are also believed to be allowable over the cited reference.

Claims 12 through 14 are dependent upon claim 11, particularly as amended, and therefore incorporate the requirements of claim 11. Thus, claims 12 through 14 are also believed to be allowable over the cited reference.

Claims 9 and 10 have been cancelled.

Withdrawal of the §103(a) rejection of claims 1-15 is therefore respectfully requested.

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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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